

April 26, 2004
Case No. DP-306204 (7500/116)
Serial No.: 09/994,306
Filed: November 26, 2001
Page 6 of 11

-- REMARKS --

Claim 20 was rejected under 35 USC 112, second paragraph. Claim 20 has been amended to obviate this rejection, and withdrawal of the rejection is requested.

Claim 22 was rejected under 35 USC 112, second paragraph. Claim 22 has been amended to obviate this rejection, and withdrawal of the rejection is requested.

Claim 23 was rejected under 35 USC 112, second paragraph. Claim 23 has been amended to obviate this rejection, and withdrawal of the rejection is requested.

Claims 13-20 were rejected as unpatentable over Watanabe in view of DeCarbon.

The rejection of claims 13-20 as unpatentable over Watanabe in view of DeCarbon is traversed. For this 103(a) rejection to stand, each and every element of the claims must be taught or suggested by the references, alone or in combination. Because the references, alone or in combination, do not teach or suggest the elements of the independent claims, as described above, the 103(a) rejections must fall.

Specifically, neither Watanabe, nor DeCarbon, alone or in combination, teach or suggest an actuating pin as claimed in claim 13. The Examiner likens the *pushrod* 30 of Watanabe to the actuating pin 106 of the instant application. However, a review of Watanabe indicates that the two structures are not similar. Watanabe teaches, at column 4, lines 14-18:

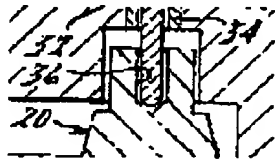
"Pushrod 30 passes through o-ring seal 32 which prevents working fluid from entering bore 82 in which the fluid motor is housed. Pushrod 30 also passes through sleeve 34 which has the function of retaining push rod o-ring seal 32." This is in direct contrast to the structure disclosed in the instant specification, and claimed in claim 13. The instant actuating pin 106 is illustrated in FIG. 3 and clearly does not pass through an o-ring seal, nor pass through a sleeve.

April 26, 2004
Case No.: DP-306204 (7500/116)
Serial No.: 09/994,306
Filed: November 26, 2001
Page 7 of 11

Further, despite the Examiner's insistence, Watanabe does not reach at least "a bridge connected to the body portion and extending at least partially beyond the upper edge of the body portion." The Attachment 1 from the Examiner illustrates this fact quite clearly. The "bridge" identified by the Examiner is more accurately described as a "bore 36" maintaining the pushrod in place. See Watanabe, column 4, lines 12-14:

shaped piston 78. Pushrod 30 is preferably integral with piston 78 and contacts the sliding valve in the area of pushrod bore 36. Pushrod 30 passes through O-ring seal

Additionally, claim 13 requires "an actuating pin in contact with the bridge to move the valve spool between an open position and a closed position." The "actuating pin" identified by the Examiner (i.e. pushrod 30) does not contact the "bridge" "to move the valve spool between an open position and a closed position." Rather, the Watanabe "bridge" serves to position the pushrod. See a selection from Watanabe FIG. 1 (attachment 1) below.



Certainly, those of ordinary skill in the art would be expected to understand the distinct and clear differences between a "bore" and a "bridge." The Applicants' claimed bridge is described with great detail throughout the specification, for example, on page 5, and FIG. 4 of the instant application is an illustration of one embodiment of a bridge in accordance with the invention.

Dictionary.com defines the noun form of "bore" in relevant part as:

n.

•A hole or passage made by or as if by use of a drill.

April 26, 2004
Case No.: DP-306204 (7500/116)
Serial No.: 09/994,306
Filed: November 26, 2001
Page 8 of 12

Dictionary.com defines the relevant noun form of "bridge" as:

n.

•A structure spanning and providing passage over a gap or barrier, such as a river or roadway.

Indeed, by teaching a pushrod entering a pushrod bore, Watanabe directly teaches away from the invention claimed in claim 13. Watanabe does not disclose, teach, or suggest a bridge as claimed in claim 13.

The Examiner correctly does not cite deCarbon as teaching "a bridge connected to the body portion and extending at least partially beyond the upper edge of the body portion" nor "an actuating pin in contact with the bridge to move the valve spool between an open position and a closed position" and therefore, the references cited do not teach or suggest each and every limitation of claim 13.

Were the instant application modified in the fashion suggested by Watanabe, the invention simply would not work, and at the least, a very significant redesign would be necessary. Modifying the Watanabe damper as suggested by the Examiner would require significant modification to the Applicants' invention and would require significant redesign – a requirement in direct contrast to the mandates of Section 103(a). See, In Re Ratti, 270 F.2d 801, 812 (CCPA 1959).

Furthermore, the mere fact that the references *could* be combined to arrive at the claimed invention (which Applicants do not concede and actively dispute) is insufficient to prove a prima facie case. See MPEP 2143.01, In Re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990) and In Re Fritch, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). While Applicants do not agree that the combination of the references would result in the claimed invention, there must be some motivation or suggestion in the references to combine to support a prima facie case of obviousness. Here, in the absence of any such motivation or suggestion, the rejection must fail.

Claims 14-20 depend from claim 13 and are therefore allowable over the references for at least the same reasons.

April 26, 2004
Case No.: DP-306204 (7500/116)
Serial No.: 09/994,306
Filed: November 26, 2001
Page 9 of 11

Claim 21 was rejected as unpatentable over Watanabe in view of Gubitz under §103(a).

The rejection of claim 21 as unpatentable over Watanabe in view of Gubitz under §103(a) is traversed.

As an initial matter, Applicants note that the Examiner has not even alleged that either Watanabe or Gubitz teach or suggest that the cylinder tube comprises "a cap welded to the tube at one end and a rod guide at an other end" as claimed in claim 21, and therefore the §103(a) rejection is flawed on its face.

Additionally, neither Watanabe nor Gubitz teach "an actuating pin in contact with a bridge to control fluid flow." The failure of Watanabe to teach the "an actuating pin in contact with a bridge to control fluid flow" is documented above, and the Examiner does not even cite to Gubitz for such a teaching. Thus, the references alone, or in combination, do not teach or suggest each and every element of claim 21 and the claim is therefore patentable over the references. Withdrawal of the rejection to claim 21 is requested.

The mere fact that the references *could* be combined to arrive at the claimed invention (which Applicants do not concede and actively dispute) is insufficient to prove a prima facie case. See MPEP 2143.01, In Re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990) and In Re Fritch, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). While Applicants do not agree that the combination of the references would result in the claimed invention, there must be some motivation or suggestion in the references to combine to support a prima facie case of obviousness. Here, in the absence of any such motivation or suggestion, the rejection must fail.

April 26, 2004
Case No.: DP-306204 (7500/116)
Serial No.: 09/994,306
Filed: November 26, 2001
Page 10 of 11

Claim 22 has been rewritten in independent form, as is allowable. Claim 23 has been amended to obviate the §112 rejection, and is allowable. Withdrawal of the rejections to claims 22 and 23 is requested.

This application is now in condition for allowance. Such action is respectfully requested, and the Examiner is invited to telephone Applicants' attorney to discuss any remaining matters.

April 26, 2004
Case No.: DP-306204 (7500/116)
Serial No.: 09/994,306
Filed: November 26, 2001
Page 11 of 11

SUMMARY

This application is now in condition for allowance, and such action is respectfully requested. The Examiner is invited to telephone the undersigned with any remaining issues.

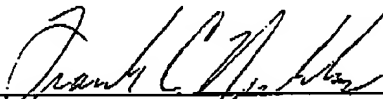
Dated: **April 26, 2004**

Respectfully submitted,
TROY A. MILLER, *et al.*

DELPHI TECHNOLOGIES, INC.
Legal Staff
PO Box 5052
Mail Code: 480-410-202
Troy, Michigan 48007-5052
Phone: (248) 813-1250

Michael D. Smith
Registration No. 40,181
Attorney for Applicants

CARDINAL LAW GROUP
Suite 2000
1603 Orrington Avenue
Evanston, Illinois 60201
Phone: (847) 905-7111
Fax: (847) 905-7113



Frank C. Nicholas
Registration No. 33,983
Attorney for Applicants